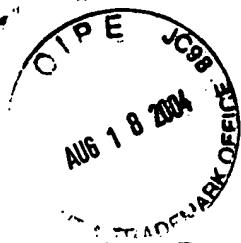


LTW



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

JANNES et al

Atty. Ref.: 2551-58

Serial No. 09/787,000

Group: 1648

Filed: March 13, 2001

Examiner: Foley

For: IDENTIFICATION OF MICROORGANISMS CAUSING ACUTE RESPIRATORY  
TRACT INFECTIONS (ARI)

\* \* \* \* \*

August 18, 2004

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Jasmine Chambers  
Group Director TC1600

Sir:

**REQUEST FOR RECONSIDERATION AND CLARIFICATION OF DECISION**  
**MAILED JUNE 18, 2004**

Reconsideration and clarification of the Decision mailed June 18, 2004  
(hereinafter "Decision") is requested for the following reasons.

The Decision is understood to provide a new determination of alleged  
patentably distinct subject matter in the four (4) Groups identified spanning pages 2-3  
of the Decision. Moreover, the Decision is understood to direct the Examiner to not  
require an election of a "specific primer pair or specific probe within the elected  
invention." See, page 5, 4<sup>th</sup> paragraph of the Decision. The Decision is further  
understood to direct the Examiner to examine, at a minimum, the full breadth of

claims 13-36, of Group I of the Decision. A clear statement of the same, or some alternative clear direction on the record, however is requested.

The Decision states that "this petition [sic, Decision?] includes a new lack of unity determination which supplies the required PCT reasoning and addresses applicants' arguments, thus fulfilling the concern of item (3)." See, page 6 of the Decision. The Decision also indicates that the applicants Petition has been "**GRANTED-IN-PART**". Presumably the "part" of the applicants Petition which has been granted is the request that the Examiner be instructed to not require an election of a specific primer pair or probe however a clear indication of the same on the record is again requested.

The Decision further defines three alleged separately patentable Groups of subject matter in the form of Groups II-IV listed on page 5 of the Decision. The undersigned respectfully submits however that the Decision does not clearly articulate how the subject matter of these Groups are separately patentable. Further clarification in this regard is requested.

Specifically, the Decision goes to some length to distinguish the subject matter of Group I from the subject matter of each of Groups II-IV however the Decision provides one paragraph, at the top of page 6 of the Decision, to conclude that the subject matter of Groups II-IV are separately patentable. Reconsideration and further clarification in this regard are requested.

The undersigned notes that the Decision groups claims to single probes or primers in Group II as apparently not being separately patentable subject matter. The combinations or collection of primers from Group II are then alleged to be separately patentable in defining the subject matter of Group III. Clarification is requested however as to how the combination of at least one patentable invention, presuming the individual primers are patentable, with another patentable or unpatentable individual subject matter (i.e., another primer) could define a separately patentable invention which either requires separate search or defines a separate special technical feature or has obtained separate status in the art as being subject matter of separate invention. Similarly, the Decision has defined a further separately patentable group of subject matter (Group IV) which is a combination of the primers and probes of Group II. Clarification and reconsideration is similarly requested as to how the subject matter of Group IV, which contain the subject matter of Group II of the Decision, could be separately patentable from the subject matter of the individual components defined in Group II.

The undersigned notes that the original restriction requirement of January 15, 2002 appears to have appreciated that claims "drawn to primers, probes, and kits" defined a single invention. See, page 2 of the Office Action dated January 15, 2002.

At a minimum, the Commissioner is requested to provide a clear statement directing the Examiner to examine, at a minimum, the full breadth of claims 13-36. Alternatively, the Commissioner is requested to indicate the breadth of the claims

✓ In re Application of JANNES et al  
Serial No. 09/787,000  
August 18, 2004

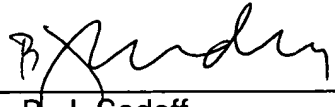
which are to be examined. Moreover, clarification of the separate patentability of the subject matter of Groups II-IV of the Decision is requested.

The Commissioner is further requested to facilitate return of a completely initialed copy of the PTO 1449 Form filed March 13, 2001, pursuant to MPEP § 609, which lists, among other things, document DE 197 456. See, pages 6-7 of the Remarks of the Amendment filed March 10, 2003.

The Commissioner is requested to contact the undersigned in the event anything further is required for grant of the present Renewed Petition.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
B. J. Sadoff  
Reg. No. 36,663

1100 North Glebe Road, 8th Floor  
Arlington, VA 22201-4714  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100